

REMARKS

At the time of the Fifth Office Action dated May 13, 2010, claims 1-14 and 16 were pending and rejected in this application.

CLAIMS 1-4, 6, 10-14, AND 16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON OWENS ET AL., U.S. PATENT NO. 6,633,630 (HEREINAFTER OWENS), IN VIEW OF NARASIMHAN ET AL., U.S. PATENT NO. 6,073,165 (HEREINAFTER NARASIMHAN), AND DEEN ET AL., U.S. PATENT NO. 6,999,992 (HEREINAFTER DEEN)

On pages 2-7 of the Fifth Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Owens, Narasimhan, and Deen. This rejection is respectfully traversed.

With regard to an obviousness rejection under 35 U.S.C. § 103, the Board of Patent Appeals and Interferences provided the following guidance within the precedential opinion of Ex parte Frye, (Appeal No. 2009-006013):

The Examiner has the initial burden to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope that he seeks – the so-called "*prima facie* case." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (the initial burden of proof is on the USPTO "to produce the factual basis for its rejection of an application under sections 102 and 103") (quoting In re Warner, 379 F.2d 1011, 1016 (CCPA 1967)). As the Federal Circuit has observed, "[t]he term '*prima facie* case' refers only to the initial examination step." Oetiker, 977 F.2d at 1445; see also Oetiker, 977 F.2d at 1449 ("The process of patent examination is an interactive one.") (Plager, J.,

concurring). The "*prima facie* case" serves as a procedural mechanism that shifts the burden of going forward to the applicant, who must produce evidence and/or argument rebutting the case of unpatentability. See *Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472. Applicant's rebuttal evidence "may relate to any of the *Graham* factors including the so-called secondary considerations." *Piasecki*, 745 F.2d at 1472 (citations omitted). The examiner then determines patentability "on the totality of the record, by a preponderance of the evidence with due consideration to the persuasiveness of argument." *Oetiker*, 977 F.2d at 1445. (emphasis in original)

Claim 1

On page 4 of the Fourth Office Action, the Examiner asserted the following with regard to the teachings of Owens and Narasimhan:

Owens did not expressly teach details regarding selecting a message filtering policy based on a communication characteristic of a link between brokering systems. IN analogous art (i.e. message communication in computer networks), Narasimhan discloses another message brokering system which discloses selecting a policy, based on the communication characteristic of the network (i.e. if server A is down, then go down the list of user defined available servers until an appropriate server is found which can route the message to the user) (col. 4, lines 30-63; col. 5, lines 25-30; col. 7, lines 1-15). (emphasis in original)

At the outset, Applicants note that the claimed language at issue is as follows:

a selection module, responsive to a communication characteristic of an inter-broker communication link effective to communicate messages between the message brokering system and one of said connected message brokering systems, configured to select a message filtering policy which is appropriate for the communication characteristic. (emphasis added)

The claimed "communication characteristic" is of "an inter-broker communication link effective to communicate messages between the message brokering system and one of said connected message brokering systems." This is entirely different than a communication characteristic of the network. Additionally, the claimed invention is directed to selecting a

message filtering policy. Narasimhan does not "select" a policy based upon a particular communication characteristic. Instead, Narasimhan uses a message routing policy. A filtering policy describes what messages are to be sent (or not sent). Unlike a message filtering policy, a message routing policy describes where messages are to be sent.

Therefore, a proper characterization of the combination of Owens and Narasimhan would recognize that the combination fails to teach (i) a communication characteristic of *an inter-broker communication link effective to communicate messages between the message brokering system and one of said connected message brokering systems*; (ii) selecting a policy based upon this *particular type* of communication characteristic; and (iii) selecting a message *filtering* policy based this particular type of communication characteristic. Instead, the combination of Owens and Narasimhan teaches that in the event of a failure with a server/database, a message routing policy is used to route messages to an alternative server and/or a mirrored database

Referring to pages 2-4 of the Fifth Office Action, the Examiner repeated the Examiner's characterization with regard to the combination of Owens and Narasimhan. As such, Applicants maintain the above reproduced arguments.

Referring to page 4 of the Fifth Office Action, the Examiner made the following assertions with regard to the teachings of Deen:

Deen taught that a communication characteristic of an inter-broker communication link effective to communicate messages is used for selecting a message filtering policy (**column 3, lines 17-25**). In Deen the characteristic in question is not whether a link is available, but a measure of redundant message transmissions over communication links that are, in fact, effective to communicate messages. (emphasis in original)

For ease of reference, the Examiner's cited passage within Deen is reproduced below:

1 In some instances, an event will occur frequently in a short period time, but sending
2 multiple notifications to the client system of the occurrence of the event would be redundant. The
3 server system accounts for this by filtering out redundant notification messages. When a
4 monitored event occurs, the server system determines when the last occurrence of the event
5 happened. If the previous occurrence was very recent, a new notification is not sent to the client
6 system.
7

8 The Examiner has grossly mischaracterized the teachings of Deen. First, Deen is
9 completely silent with regard to the claimed *inter-broker communication link*. Second, Deen does
10 not refer to a *communication characteristic* of the inter-broker communication link. Deen describes
11 monitoring "events" and sending notifications to a client system upon the occurrence of the event.
12 However, the Examiner has produced no substantial evidence to support a finding that the events
13 are (i) a communication characteristic or (ii) related to an inter-broker communication link in any
14 manner.
15

16 Third, Deen is silent as to these "events" being used to select a message filtering policy.
17 Although Deen describes a message filtering policy (i.e., "filtering out redundant notification
18 messages"), neither the Examiner's analysis nor the teachings of Deen explain how this message
19 filtering policy is selected. Instead, the selecting described by Deen is part of the message filter
20 policy itself – i.e., a message is selected to be filtered if a previously occurrence of the message was
21 very recent.
22

23 The Examiner asserts that "Deen taught that a communication characteristic of an inter-
24 broker communication link effective to communicate messages is used for selecting a message
25 filtering policy." Should the Examiner maintain the present rejection, for purpose of clarifying
26 the record prior to appeal, Applicants respectfully request that the Examiner specifically identify the
27 allege features with Deen that allegedly corresponds to:

- (i) a communication characteristic;
- (ii) an inter-broker communication effect to communicate messages;
- (iii) a message filter policy;
- (iv) using the communication characteristic to select the message filter policy.

Applicants, therefore, respectfully submit that the Examiner has committed error by improperly determining the scope and content of the prior art, which is one of the Graham factual inquiries. Additionally, since the Examiner has failed to recognize that Deen does not teach all the limitations for which the Examiner is relying upon Deen to teach, the Examiner has also committed error by failing to properly ascertain the differences between the applied prior art and the claims at issue, which is another one of the Graham factual inquiries. Thus, the Examiner has not set forth a proper prima facie of obviousness.

The Examiner's obviousness analysis is also found on page 4 of the Fifth Office Action and is reproduced below:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to further modify the methods/systems of Owens combined with Narasimhan, with the teachings of Deen. Owens motivated the exploration of the art of selecting filtering policies (column 8 lines 29-31). The combination of Owens with Narasimhan would have been improved with the teachings of Deen to avoid wasting network bandwidth by forwarding redundant messages (see Deen column 2 lines 15-17).

As stated by the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the Examiner's articulated reasoning is not support by a rational underpinning. As noted above, the combination of Owens and Narasimhan teaches that in the event of a failure with a server/database, a message routing policy is used to route messages to an alternative server and/or a mirrored database. The Examiner's tertiary reference of Deen and the teachings relied upon by the Examiner have no reasonable relevance to these teachings of the combination of Owens and Narasimhan.

Moreover, one having ordinary skill in the art does not have to modify the combination of Owens and Narasimhan to realize the benefits of Deen. Specifically, the alleged benefits of Deen (i.e., "to avoid wasting network bandwidth by forwarding redundant messages") is obtained by using a message filtering policy that selects a message to be filtered if a previously occurrence of the message was very recent. This can be employed as a completely separate unit to the proposed combination of Owens and Narasimhan. As such, although the Examiner has supplied a rationale to modify the combination of Owens and Narasimhan, the resultant combination (based upon the Examiner's rationale) would not render the claimed invention obvious.

For the reasons stated above, Applicant respectfully submits that the imposed rejection of claims 1-4, 6, 10-14, and 16 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Deen is not viable. Hence, Applicants solicits withdrawal thereof.

**CLAIM 5 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON OWENS IN
VIEW OF NARASIMHAN, DEEN, AND KHAN ET AL., U.S. PATENT PUBLICATION NO.
2002/0143951 (HEREINAFTER KHAN)**

On pages 7 and 8 of the Fifth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Deen, and Khan to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 5 depends from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Deen. The additional reference to Khan does not cure the argued deficiencies of Owens, Narasimhan, and Deen. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan, Deen, and Khan is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 7 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
OWENS IN VIEW OF NARASIMHAN, DEEN, AND DELANEY ET AL., U.S. PATENT PUBLICATION
NO. 2001/0027479 (HEREINAFTER DELANEY)**

On pages 8 and 9 of the Fifth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Deen, and Delaney to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 7 depends from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Deen. The additional reference to Delaney does not cure the argued deficiencies of Owens, Narasimhan, and Deen. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claim 7 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan, Deen, and Delaney is not viable and, hence, solicit withdrawal thereof.

CLAIMS 8 AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON OWENS IN VIEW OF NARASIMHAN, DEEN, DELANEY AND KHAN

On pages 9-11 of the Fifth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Deen, Delaney, and Khan to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 8 and 9 depend from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Deen. The additional references to Delaney and Khan do not cure the argued deficiencies of Owens, Narasimhan, and Deen. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claims 8 and 9 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan, Deen, Delaney, and Khan is not viable and, hence, solicit withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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